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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,395	02/12/2002	James W. McMichael	44598A	3836

22515 7590 01/07/2004

THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
2301 N BRAZOSPORT BLVD
FREEPORT, TX 77541-3257

EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	6

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary	Application No.	Applicant(s)	
	10/049,395	MCMICHAEL ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 20, 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-71* is/are pending in the application.

4a) Of the above claim(s) *52-56,70 and 71* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-51 and 57-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *41-71* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This office action follows a response filed on October 20, 2003. Applicants have canceled claims 1-40 and 73-83. Claims 41-51 and 57-69 remain active. Claims 52-56, 70, and 71 have been withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 41-51, 57, 58, and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,433,097 to Tawada *et al.* in view of U.S. Patent No. 5,739,200 to Cheung *et al.* for the same reasons set forth in the previous office action (Paper No. 4). To recapitulate, it can be gleaned from Tawada *et al.* that the method would be applicable to a variety of host resins. As such, the skilled artisan would have found it obvious to use the polymers of Cheung *et al.* in the same process described in Tawada *et al.* in order to arrive at the subject matter of present claims.

4. Claims 41, 57-62, and 64-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,060,510 to Himes *et al.* for the same reasons set forth in Paper No. 4.

5. Claims 41-51, 57-62, 64-69 rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/10015 to Park *et al.* for the same reasons set forth in the previous office action.

Response to Arguments

6. Claim objections and claim rejections under 35 U.S.C. 112, 2nd paragraph, have been withdrawn.

7. Applicants traverse the rejection of claims 41-51, 57, 58, and 61-63 under 35 U.S.C. 103(a) as being unpatentable over Tawada *et al.* in view of Cheung *et al.* Applicant's arguments have been considered fully, but they are not persuasive.

Applicants offer boilerplate arguments indicating that a prima facie case of obviousness has not been met. The skilled artisan must recall the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, Tawada *et al.* discloses a general process for producing a mechanical mixture of talc and polymer particles wherein talc may be partially adhered to polymer particles by embedding the filler within the polymer particles. The skilled artisan would realize that the

general method would be applicable to any host resin other than the ones mentioned in the reference. Therefore, the skilled artisan would have found it obvious to produce a mechanical mixture of talc with the vinylidene aromatic interpolymers of Cheung *et al.* The skilled arstian would have expected such an embodiment to work because the patent demonstrates the process adequately. Finally, all elements of the present invention are found in the two cited references. No teachings have been culled from an unidentified source. As such, the three criteria for establishing a *prima facie* case of obviousness (as per *In re Vaeck*) have been met.

In view of the discussion above, the rejection of record has not been withdrawn.

8. Applicants traverse claim rejections in view of Himes *et al.* and in view of Park *et al.* Applicants contend that neither of the materials taught in the prior art possesses the claimed properties. This allegation is insufficient in meeting the burden of proof to establish any unobviousness differences between the claimed invention and that of the prior art. Therefore, the rejections have not been withdrawn.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-1104.

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January 2, 2004

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700